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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,241	08/29/2001	Krishan Chari	82300D-W	9136

7590 10/28/2003
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EXAMINER

FORMAN, BETTY J

ART UNIT PAPER NUMBER

1634

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/942,241

Applicant(s)

CHARI ET AL.

Examiner

BJ Forman

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-24 and 26-34.

Claim(s) withdrawn from consideration: 35-40.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE:

The proposed amendments further define the claimed microarray as a "random" microarray. The definition is inserted into the preamble of Claim 1 but does not alter the components of the claimed composition. Therefore, the proposed amendment to Claim 1 does not materially reduce or simply issues for appeal. Furthermore, the proposed amendments add new Claims 41-42 without canceling a corresponding number of finally rejected claims. New claim 41 and 42 add limitations "fluid capable of sol-to-gel transition" and "immobilized at random positions on a substrate when said sol-to-gel transition occurs". These new limitations have not previously been considered. Therefore, the proposed new claims would require further search and consideration.


For the reasons stated above, the proposed amendments will not be entered.

Response to Applicant's Comments:

Applicant provides a definition of "random distribution" provided in the specification. Applicant argues that Walt et al do not teach or suggest the random distribution as defined in the specification. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., random distribution means a spatial distribution of elements showing no preference or bias...entirely random....the microspheres are not attracted or held to sites that are pre-marked or predetermined on the substrate as in other methods previously disclosed....the microspheres are immobilized randomly when the gelling agent in which they are carried undergoes a sol-to-gel transition) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that Walt et al and McGall et al do not teach the instantly claimed gelling agent. The argument has been considered but is not found persuasive because as stated in the Final Office Action, the references teach the gelling agent as defined in the specification.

Applicant argues that Anderson et al do not teach "spreading the microspheres uniformly on the surface in the fluid state prior to immobilization via a sol to gel transition. The argument has been considered but is not found persuasive because the argument is not commensurate in scope with the rejected claims which do not recite sol to gel transition. Furthermore, the argument addressed method steps of spreading. It is noted that the claims are drawn to a composition and a microarray comprising the composition. Therefore, arguments regarding method steps of making and/or using the composition are not relevant to the instant claims.


BJ FORMAN, PH.D.
PRIMARY EXAMINER